

REMARKS / DISCUSSION OF ISSUES

Claims 1-22 are presented for further consideration. Claims 1, 8, 9, 11, 15, 19 and 21 are independent claims. Claims are amended for solely non-statutory reasons, such as to delete European-style phrasology (e.g., reference characters that are required in European practice). Claims have also been amended to remedy potential antecedent basis issues.

Rejection under 35 U.S.C. § 101

The Office Action rejects claim 19 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. (Applicants note that claim 19 is rejected, but reference is made to claim 15 as well in the rejection. It seems that reference to claim 15 is erroneous, likely typographical in nature. As such, the present response deals only with the substantive rejection of claim 19.)

Applicants respectfully traverse this rejection for at least the following reasons.

The Office Action states that:

- As per claim 19, Applicant has claimed “a computer program” for causing a computer to “control” instructions in the preamble to these claims; this implies that Applicant is claiming a system of software, per se, lacking the hardware necessary to realize any of the underlying functionality. Therefore, claim 15 is directed to non-statutory subject matter as computer programs, per se, i.e. the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed

elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

The USPTO Official Gazette Notice dated 22 November 2005, entitled "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" ("the OG Notice") provides guidelines for patent examiners. Like the MPEP, these guidelines do not have the full force and effect of law (see the OG Notice, Section I, second paragraph), but are nonetheless useful in the examination process, as is the MPEP. The undersigned attorney has thoroughly reviewed these guidelines and respectfully submits that the rejection of claim 19 is not compliant with these guidelines.

At the outset, Section IV of the OG Notice explains in detail the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. The only references to "tangible results" (i.e., things or acts) in this procedure appear under Step IV(C) – "*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*" Not surprisingly, the first thing the Examiner must do under Step IV(C) is to "*determine whether [a claim] covers either a Sec. 101 judicial exception or a practical application of a Sec. 101 judicial exception.*" Only if such a determination is made, does the analysis then proceed to determine if the claimed subject matter is nevertheless still patentable subject matter, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

Here, the Office Action does not even attempt to determine whether any or all of claim 19 covers either a Sec. 101 judicial exception (Law of Nature, Natural

Phenomenon, or Abstract Idea) or a practical application of a Sec. 101 judicial exception. Rather, the claim is dismissed as being directed to non-physical ‘things’ and is not an ‘act’ being performed. Moreover, the claim is dismissed as not defining any structural and functional interrelationships between a computer program and other claimed elements of the computer. Based on these assertions, the Examiner relegates claim 19 as being directed to non-statutory subject matter without endeavoring determine if the claim is directed to any law of nature, natural phenomenon, or abstract idea.

Claim 19 is drawn toward a computer program for controlling a networked device where the networked device has a transport stack and an application. The program and its controlling of a networked device do not cover any law of nature, natural phenomenon, or abstract idea. Accordingly, the entire analysis as to whether the claim is a ‘thing’ or an ‘act’ is not only impertinent because this is not the basis for analysis of Sec. 101 subject matter; but also, because the claim is not even directed to any Sec. 101 judicial exception in the first place.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 19 is all patentable under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 4-9, 11, 13-18 and 20-22 are rejected under 35 U.S.C. § 102(e) as being unpatentable in view of *Zintel, et al.* (US Patent Publication 2002/0029256). For at least the reasons set forth herein, Applicants respectfully submit that the rejection is improper and should be withdrawn.

At the outset, Applicants respectfully submit that the application of the particular subsection of the Code in this rejection may not be appropriate, and thus traverse the rejection on at least these grounds.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g.,*

W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Claims 1, 8, 9, 11 and 15

Claim 1 recites:

A method of operation of a networked device in a network having at least one other device, the method including:
sending a simple device description query message to at least one other device requesting a simple device description;
receiving from the other device a simple device description message of defined length including a device type value representing the type of the other device;
sending an extended device description query message to the other device requesting an extended device description from the other device; and
receiving from the other device an extended device description of variable length.

Claim 8 recites:

A method of operation of a networked device, including:
receiving a simple device description query message from at least one other device requesting a simple device description;

sending to the other device a simple device description message of defined length including a device type value representing the type of the networked device;
receiving an extended device description query message from the other device requesting an extended device description from the networked device; and
sending to the other device an extended device description of variable length.

As will be appreciated, claim 8 includes subject matter similar to that of claim 1.

The Office Action directs applicants to the Abstract for the alleged disclosure of the sending of a simple device description query message to the at least one other device. However, there is only the disclosure of the learning more about a device by an entity by retrieving the device's description. Specifically, there is no disclosure in the Abstract as alleged of a query to the at least one other device, but rather only the receipt of the device's description.

In addition, Applicants note that both a simple device description query and an extended device description query are sent according to the method. The method includes receiving both a simple device description and an extended device description. Thus two distinct queries are sent and two distinct descriptions are received. However, the Office Action relies on one and the same aspect of the Abstract to meet both the transmitting of the query of both the simple and extended. Assuming arguendo that the reference discloses that any query message is sent, there is no disclosure of sending a simple device description query and an extended device description query; and the same disclosed subject matter of the Abstract cannot properly suffice for both as the Examiner alleges. Finally, a word search of the term 'extended' in context, reveals only the term 'extended error information' and not an extended device description as claimed. (Applicants note that the applied reference includes 46 pages of text and 51 drawings Figs. As such, Applicants focus their rebuttal mostly in direct reply to the alleged disclosure of elements as specified in the Office Action.)

Furthermore, the Office Action fails to articulate with any specificity the disclosure *Zintel, et al.* of either the defined length or variable length message of any

type. As such, Applicants respectfully submit that for at least this reason, a clearly articulated rejection in conformance with MPEP § 706 has not been provided. Therefore, Applicants respectfully request that the Examiner identify the alleged disclosure of the defined and variable length messages as recited in claims 1 and 8, or withdraw the rejection.

For at least the reasons set forth above, Applicants respectfully submit that the applied art as relied upon in the Office Action fails to disclose at least one feature of claim 1. Therefore claim 1 is patentable over the applied art. Moreover, claims 2-8, which depend from claim 1, are patentable for at least the same reasons.

a. Claims 9, 11 and 15

Claims 9, 11 are drawn to networked devices and claim 15 is drawn to a system. Each claim includes features similar to those of claim 1, and particularly of the sending of both simple and extended device description queries and the receiving of both simple and extended device descriptions. The Office Action applies *Zintel, et al.* in substantially the same manner. Therefore, Applicants respectfully submit that the applied art as relied upon in the Office Action fails to disclose at least one feature of each of claims 9, 11 and 15. Accordingly, claims 9, 11 and 15 are patentable over the applied art. Moreover, claims 10, 12-14 and 16-18, which depend from respectively from claims 9, 11 and 15 are patentable for at least the same reasons.

i. Claim 21

Claim recites:

*A network establishment and management protocol for controlling electronic devices, the protocol being recorded on a record medium, the protocol comprising:
a compression algorithm (210) defining the mechanism for compression of said messages a definition (200) of a generic message format, the messages being compressed XML compliant messages; and*

a definition (204) of message sequencing requirements.

The Office Action directs Applicants to paragraph [010] of *Zintel, et al.*:
the protocol comprising: a compression algorithm (210) defining the
mechanism for compression of said messages a definition (200) of a
generic message format, the messages being compressed XML
compliant messages, **[The description is expressed in XML and
includes vendor-specific manufacturer information like the model
name and number, serial number, manufacturer name, URLs to
vendor-specific Web sites, etc. The description also includes a
list of any embedded devices or services, as well as URLs for
control, eventing, and presentation, (Paragraph 0010)];**

Applicants cannot garner the relation of the disclosure of *Zintel, et al.* relied upon
in the Office Action to the subject matter claimed in claim 21. Specifically, there is no
description of a compression algorithm defining the mechanism for compression as
specifically claimed. As such, Applicants respectfully submit that a *prima facie* case of
anticipation has not been established as to claim 21. Thus claim 21 and claim 22, which
depends from claim 21, are patentable over the applied art.

Rejections under 35 U.S.C. § 103

Claims 3, 10 and 12 are rejected under 35 U.S.C. § 10(a) as being unpatentable in
view of *Zintel, et al.* and *Unger, et al.* (US Patent 6,005,759). Claims 3, 10 and 12 depend
either immediately or ultimately from claims 1 and 9, respectively. While Applicants by
no means concede the propriety of the rejection for obviousness, claims 3, 10 and 12 are
submitted as being allowable at least because of their dependence on independent claims

that are believed allowable for at least the reasons set forth above. Withdrawal of the rejection of claims 3, 10 and 12 is earnestly solicited.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos, Esq./

by: William S. Francos (Reg. No. 38,456)

Date: December 21, 2007

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